

### Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed March 28, 2005

Claims 1 - 23 were pending in the Application prior to the outstanding Office Action. The Office Action rejects claims 1 – 23. This Response amends claims 1, 8, 15 and 20 and adds new claim 24 for clarity. No new matter is added. Accordingly, claims 1 - 24 are in condition for allowance. Reconsideration of the rejections and allowance are respectfully requested.

### Rejection under 35 U.S.C. § 103(a)

The Examiner maintains rejection of claims 1 - 23 as unpatentable over the Electronic Industries Association (EIA) JESD22-C101 Test Method (1995) [Applicant provided reference], in view of Nakaie et al. (U.S. Patent 5,740,007 (1998)).

On pages 3 – 11, the Examiner asserts that “Nakaie is teaching simulation discharge specifically discharged current with appropriate capacitance.” (Office Action, item 3, paragraph 2). According to the Examiner, such teaching is provided in the Nakaie Abstract by reciting “...at the integrated circuit for connection to the grounding conductor in order to release electric charge from the integrated circuit to the grounding conductor...coupled with the excerpt: “Because of the smaller inductance L, furthermore, the CMD simulators of this invention can freely make any desired waveform by adding appropriate capacitance (column 3, lines 14 – 16).”

The Examiner therefore concludes, “one of ordinary skill in the art would deduce that capacitors by nature charge and discharge.” Therefore, “the fact that Nakaie doesn’t state verbatim a “charged capacitor” is immaterial in light of the art taught”, and that claim 1 is therefore rendered obvious under section 103. Applicant respectfully traverses.

Even if capacitance were to be added to Nakaie's conductor attached to the mercury switch, the discharge path remains through the mercury switch and, as stated in Nakaie's "background" inductance remains a problem (Nakaie, col. 1: lines 51 – 55).

Applicant's solution instead replaces the mercury switch-based discharge path with a resistor through the addition of a pre-charging of the charge capacitor, whether or not the mercury switch is actually provided. This is made clear by amended claim 1 reciting, "whereby closing of said discharge switch subsequent to said charge being stored on said charge capacitor causes said current transient to be discharged through said device under test via said resistor" and the presence of new dependent claim 24.

Because applicant's claimed embodiment uses a different discharge path, the inductance of the mercury switch, if used, is no longer a problem. Nakaie's brief reference to capacitance discloses only modification of their grounding conductor (Nakaie, col. 3:lines 14 – 16). Nakaie even teaches away by instead modifying the inductance of their only discharge path, which is still through a mercury switch. Nakaie even admits that added capacitance may be needed to produce a desired waveform even though their method provides "smaller inductance L" (Nakaie, col. 3:lines 14 – 16). In other words, the inductance, though smaller, remains a problem using their method.

Claim 1 also recites instead adding a charge capacitor OUTSIDE of the discharge path. Nakaie teaches away for this reason as well.

Also, Nakaie's briefly mentioned capacitance is added in series with the opposing side of the mercury switch. Nakaie teaches away for this reason as well.

Also, the office action cannot alter the basic principle of operation of the prior art references (MPEP § 2143.01), i.e., the office action cannot change the path that is specifically the subject of the prior art and cannot remove the mercury switch from the discharge path since it is the inductance of the switch that the prior art seeks to modify (Nakaie, col. 1: lines 51 – 55).

Because the asserted references, EIA and Nakaie, alone or in any combination fail to teach suggest or otherwise render obvious the claimed embodiments, teach away and would be rendered inoperable if attempted to be used in the manner suggested by the Examiner, the rejections of the Office Action are improper and should be removed.

**Claims 8, 15 and 20**

Claims 8, 15 and 20, while independently patentable, each recites limitations that are similar to those described above with respect to claim 1. Therefore, for at least the reasons stated above with respect to claim 1, the Applicant respectfully submits that claims 8, 15 and 20 are allowable over the art of record and are in condition for allowance.

**Claims 2 – 7, 9 – 14, 16 – 19 and 21 – 23**

Claims 2 – 7, 9 – 14, 16 – 19 and 21 – 23 are dependent upon Claims 1, 8, 15, and 20 respectively, and thus include each and every feature of the corresponding independent claims. Each of Claims 2 – 7, 9 – 14, 16 – 19 and 21 – 23 is therefore allowable for the reasons given above for the Claims 1, 8, 15, and 20. In addition, each of Claims 2 – 7, 9 – 14, 16 – 19 and 21 – 23 introduces one or more additional limitations that independently render it patentable. Therefore, it is respectfully submitted that Claims 2 – 7, 9 – 14, 16 – 19 and 21 – 23 are allowable for the reasons given above with respect to Claims 1, 8, 15, and 20.

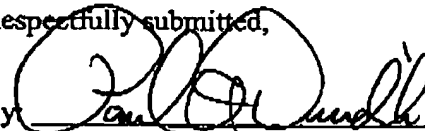
In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time that may be required.

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Respectfully submitted,

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